



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,510	03/24/2004	Tao Lu Lowe	059516-0058	3378
7590 01/05/2009 MCDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096				
EXAMINER FUBARA, BLESSING M				
ART UNIT 1618		PAPER NUMBER		
MAIL DATE 01/05/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

<b>Application No.</b> 10/807,510	<b>Applicant(s)</b> LOWE ET AL.
<b>Examiner</b> BLESSING M. FUBARA	<b>Art Unit</b> 1618

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 05 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

/Michael G. Hartley/  
Supervisory Patent Examiner, Art Unit 1618

Continuation of 3. NOTE: The proposed amendment to claim 1 introducing limitations from claim 3 does not place the claims in condition for allowance and would not simplify issues on appeal because claim 3 was rejected as being rendered obvious over Hennink in view of Merchant for reasons of record. Entry of the proposed amendment after final would mean making new rejection over the same references where finally rejected claims 1, 2, 4-6, 8, 9, 16-21 and 23 under anticipation by Hennink would be rejected under 35 USC 103(a). Thus, since a new rejection after final would be necessitated by the proposed amendment and since the proposed amendment does not place the claims in condition for allowance, the proposed amendment after the final rejection is not being entered. Applicant argues that the rejection of claim 1 as being anticipated by Hennink should be withdrawn because Hennink does not teach the polymers of claim 3 that are proposed to be included in claim 1. The examiner does not agree that the rejection should be withdrawn because the proposed amendment is not entered and even if the proposed amendment were entered, the claims amended as proposed are not allowable because the same rejection against claim 3 would apply to the proposed amended claim 1. Furthermore, the arguments are made for claim amendment that is not entered after final. Applicant argues that Merchant teaches away from using poly N-isopropylacrylamide because hydrogels obtained with poly N-isopropylacrylamide are not bioadhesive while the purpose of Merchant is to prepare bioadhesive hydrogels. The examiner disagrees. Merchant is a secondary reference providing a teaching that hydrogels formed from poly N-isopropylacrylamide are known so that the artisan would look to hydrogels from poly N-isopropylacrylamide and not for bioadhesive nature or lack of bioadhesive nature of the hydrogel from poly N-isopropylacrylamide because Hennink does not require a bioadhesive hydrogel. Therefore claim 1 is not allowable even as proposed to be amended after the final rejection. The rejection under 35 USC 112, 2<sup>nd</sup> is withdrawn in view of applicant's persuasive argument that "elastin-like polypeptides" is a term of art.

The declaration under 37 CFR 1.132 filed 12/05/08 is sufficient to overcome the rejection of claim 3 based upon rejection under 35 USC 112, 2nd in view of the presentation that "elastin-like polypeptide" is a term of art as seen in paragraph of 2.2.1 at page 127 of the article in Mat. Sci. Eng. R 2008 62 (4) by Chow et al.

However, since the proposed amendment to claim 16 is not entered, the rejection under 35 USC 112, 2nd remains. It may be brought to applicant's attention that the recitation of "substance" remains in the claim as proposed to be amended, so that the proposed amendment would not overcome the objection to the recitation of substance whose meets and bounds are unclear and not defined.

/BF/